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This is a full and timely response to the final Official Action mailed September 6, 2006. Reconsideration of the application in light of the foregoing amendments and the following remarks is respectfully requested.

Request for Continued Examination:

Applicant hereby requests Continued Examination for this application and entry and consideration of this amendment consequent thereto.

Claim Status:

Claims 37-60 and 67 were withdrawn under a previous Restriction Requirement and cancelled without prejudice or disclaimer. By the present paper, various claims are amended. However, no claims are added or cancelled. Thus, claims 1-36 and 61-66 are currently pending for further action.

Applicant wishes to note that the various amendments made to the claims in the present paper merely clarify subject matter already inherent in the original claims. Consequently, these amendments are not intended to narrow or change the scope of the claims. However, it is hoped that these clarifications, such as the express definitions within the claims of print and data files, will enable the Examiner to better see the clear differences between Applicant's claims and the prior art of record.

Prior Art:

Claims 1-12, 14, 15, 19-36, 61-63, 65 and 66 were rejected as being unpatentable under 35 U.S.C. § 103(a) over the combined teachings of U.S. Patent No. 6,633,888 to

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Kobayashi ("Kobayashi") and U.S. Patent No. 5,611,066 to Keele ("Keele"). This rejection is respectfully traversed for at least the following reasons.

Claim 1 recites:

A method of creating an archived file in a manner that allows an application to distinguish between one or more data files and one or more print files in said archived file, *wherein said print files contain data used by said application to print visual labeling associated with data of one or more of said data files and said data files provide data to be transferred by said application to a recording medium associated with said visual labeling*, said method comprising

generating a manifest file; and

including said manifest file in said archived file;

wherein said manifest file distinguishes between one or more data files and one or more print files in said archived file and indicates to said application a file location within said archived file associated with said one or more data files and a file location associated with said one or more print files.

(Emphasis added).

Independent claim 61 recites:

A system for creating an archived file in a manner that allows an application to automatically distinguish between one or more data files and one or more print files in said archived file, *wherein said print files contain data used by said application to print visual labeling associated with data of one or more of said data files and said data files provide data to be transferred by said application to a recording medium associated with said visual labeling*, said system comprising:

means for generating a manifest file, *said manifest file distinguishing between one or more data files and one or more print files in said archived file and indicating to said application a file location associated with said one or more data files and with said one or more print files*; and

means for including said manifest file in said archived file.

(Emphasis added).

Independent claim 66 recites:

A processor readable medium having instructions thereon for:

generating an archived file comprising one or more print files and one or more data files, wherein said print files contain data used to print visual labeling associated with data of one or more of said data files and said data files provide data to be transferred to a recording medium associated with said visual labeling;

generating a manifest file; and

including said manifest file in said archived file;

wherein said manifest file distinguishes between one or more data files and one or more print files in said archived file and indicates to an application a file

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location within said archived file associated with one or more data files and a file location associated with one or more print files.
(Emphasis added).

With regard to the amendments to these claims, Applicant refers to Applicant's originally-filed specification at, for example, paragraphs 0002, 00017-18 and 0036.

In contrast, the combination of Kobayashi and Keele fails to teach or suggest the claimed method in which an archived file contains both print and data files, and a manifest file is included in the archived file that identifies both print and data files and their respective locations within the archived file. In this regard, the recent Office Action repeatedly cites Kobayashi at col. 7, lines 49-51. (Action of 9/6/06, p. 3). This portion of Kobayashi reads as follows:

Because Java programs are intended to be transmitted over the Internet, the final program is packaged into what is referred to as a Java Archive (JAR) file. The JAR file is actually a "zipped", or compressed, file which includes all related files for that application, applet, or component. Also included in the JAR file is a manifest file, which includes extra information concerning the zipped portion of the file. For example, the manifest file can indicate the contents of the JAR file and whether a particular zipped file is a bean or a resource file, its file version number, and so on. (Kobayashi, col. 7, lines 46-55).

Thus, Kobayashi teaches a method of delivering Java programs *via the Internet* in an archive or "JAR" file with a manifest file that distinguishes between bean and resource files and gives file version number. The manifest file taught by Kobayashi does not, however, specify file locations.

It is clear, therefore, that Kobayashi does not teach or suggest the claimed archived file that includes both print files and data files, "wherein said print files contain data used by said application to print visual labeling associated with data of one or more of said data files and said data files provide data to be transferred by said application to a recording medium associated with said visual labeling." Kobayashi has nothing to do with the claimed

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method of creating an archived file including print and data files with a manifest file that distinguishes the location and the type of the print and data files within the archived file.

The teachings of Keele do not in any way remedy these shortcomings of Kobayashi. Keele teaches that printed material associated with a compact disc (CD) is generated using data written on the CD itself. According to Keele, "CD-W labels, packing slips, etc. are printed, normally off-line, for each CD-W *from the unique data stored within the CD-W itself.*" (Keele, abstract) (emphasis added). Keele does not teach or suggest an archived file that includes separate data and print files, or a manifest file that distinguished between and locates each such type of file.

In this regard, the Office Action argues that taken together Kobayashi and Keele somehow teach an archived file that includes both print and data files. (Action of 9/6/06, p. 13). However, the Action has provided no reason or motivation grounded in the prior art as to why one of skill in the art would have included the disc labeling files taught by Keele in the Java JAR file, transmitted via the Internet, as taught by Kobayashi. There appears to be no reasonable reason for doing so. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1420 (Fed. Cir. 1990)." M.P.E.P. § 2143.01. Thus, the Kobayashi and Keele references, taken together, do not teach or suggest a single archived file that includes both print and data files as claimed by the Applicant.

Additionally, the combined teachings of Kobayashi and Keele fail to teach or suggest other features of claim 1, particularly, a manifest file that "distinguishes between one or more data files and one or more print files in said archived file and indicates to said application a file location within said archived file associated with said one or more data files and a file

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location associated with said one or more print files." The manifest file taught by Kobayashi does not distinguish between print and data files and does not indicate file locations within an archived file. Keele teaches nothing about a manifest file. Thus, the combination fails to teach or suggest the manifest file as claimed by Applicant.

"To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j). Therefore, for at least these reasons, the rejection of claims 1, 61, 66 and their respective dependent claims based on Kobayashi and Keele should be reconsidered and withdrawn.

Independent claim 23 recites:

A method of creating an archived file in a manner that allows an application to distinguish between one or more data files and one or more print files in said archived file, *wherein said print files contain data used by said application to print visual labeling associated with data of one or more of said data files and said data files provide data to be transferred by said application to a recording medium associated with said visual labeling*, said method comprising:

using an enforced directory structure in said archived file;

wherein said enforced directory structure separates one or more data files and one or more print files in said archived file and indicates to said application a file location associated with said one or more data files and a file location associated with said one or more print files.

(Emphasis added).

With regard to the amendments to claim 23, Applicant refers to Applicant's originally-filed specification at, for example, Fig. 4 and the associated text.

In contrast to claim 23, as demonstrated above, neither Kobayashi nor Keele teach or suggest an archived file that includes both data and print files. Kobayashi teaches a JAR file containing Java programs, and does not teach or suggest an archived file including print and data files as claimed. Similarly, Keele does not appear to teach or suggest an archived file

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including print and data files as defined and claimed by the Applicant. Consequently, the combination of Kobayashi and Keele cannot teach or suggest such an archived file with an enforced directory structure that separates and identifies the location of print files as opposed to data files.

"To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j). Therefore, for at least these reasons, the rejection of claim 23 and its dependent claims based on Kobayashi and Keele should be reconsidered and withdrawn.

Additionally, the various dependent claims of the application recite subject matter that is clearly patentable over the prior art of record. Specific, non-exclusive examples follow.

Claim 2 recites:

The method of claim 1, further comprising:
extracting files from said archived file with said application, said files including said one or more data files, said one or more print files, and said manifest file;
burning said one or more data files onto an optical disc; and
printing content corresponding to said one or more print files.

Claims 24 and 62 recites similar subject matter.

In contrast, as demonstrated above, Kobayashi and Keele do not teach or suggest print files in an archived file because there is no reason to include the labeling files of Keele in the JAR file of Kobayashi. Thus, the combination cannot teach or suggest extracting data *and* print files from an archived file and printing content corresponding to the one or more extracted print files. Rather, as demonstrated above, Keele teaches extracting data written to

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a CD to generate printed labeling, etc. for the disc. (Keele, col. 28, line 64-67).

Consequently, the combination of Kobayashi and Keele fails to teach or suggest all the features of claim 2, 23 or 62. For at least this additional reason, the rejection of claims 2, 23, 62 and their respective dependent claims should be reconsidered and withdrawn.

Claim 20 recites:

The method of claim 1, further comprising:
including said manifest file in any directory of said archived file; and
including a boot file in a root directory of said archived file, said boot file
indicating a path of said manifest file in said archived file;
wherein said application is configured to recognize and read said boot file.

In contrast, the combination of Kobayashi and Keele fails to teach or suggest this subject matter. In this regard, the Office Action cites Keele at col. 41, lines 19-21. (Action of 9/6/06, p. 8). However, this portion of Keele discusses a boot record that is potentially used to boot a computer from a CD. According to Keele, "[a] Boot Record consists of potentially several optional fields permitting the user to specify information about the boot record. However, CD-W standards do not currently support booting off the CD, so this feature is reserved for future use." (Keele, col. 41, lines 19-21).

Consequently, the boot record taught by Keele has nothing to do with the boot file claimed by Applicant. The recent Office Action disagrees "because there is nothing clearly stated within the claim language to distinguish applicant 'boot file' from Keele's 'boot record.'" (Action of 9/6/06, p. 14). This is clearly incorrect. Applicant's boot file indicates "a path of said manifest file in said archived file." (Claim 20). Keele's boot record does not.

Additionally, Applicant's boot file is located "in a root director of said archived file." Keele's boot record is not. In this regard, the Office Action argues that "it is impermissible for the applicant to solely argue, Keele does not disclose the boot record being part of the

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archived file, because the archived file was disclosed within the Kobayashi reference, and was incorporated from there on out.” (Action of 9/6/06, p. 14). This is incorrect because the Office Action fails to give any explanation demonstrating why one of skill in the art would have included the boot record taught by Keele in the JAR file taught by Kobayashi. As noted above, Kobayashi teaches the transmission of JAVA files over the internet, not on a disc or other tangible medium. Consequently, there appears to be no reason why one of skill in the art would have included a boot record that is used to boot a computer from a CD as taught by Keele in the JAR file taught by Kobayashi. Therefore, it is the Office Action that has impermissibly assumed that the combination of Kobayashi and Keele somehow teaches the claimed boot file in an archived file. The cited combination teaches no such thing.

Thus, the boot record taught by Keele is not part of an archived file and does not indicate the location of a manifest file that is also in the archived file as claimed. For at least this additional reason, the rejection of claim 20 should be reconsidered and withdrawn.

Claims 13, 16-18 and 64 were rejected under 35 U.S.C. § 103(a) over the combined teachings of Kobayashi, Keele and U.S. Patent Application Publication No. 20040019596 by Taylor (“Taylor”). This rejection is respectfully traversed for at least the same reasons given above with respect to the independent claims of the application.

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Conclusion:

For the foregoing reasons, the present application is thought to be clearly in condition for allowance. Accordingly, favorable reconsideration of the application in light of these remarks is courteously solicited. If the Examiner has any comments or suggestions which could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,

DATE: November 3, 2006



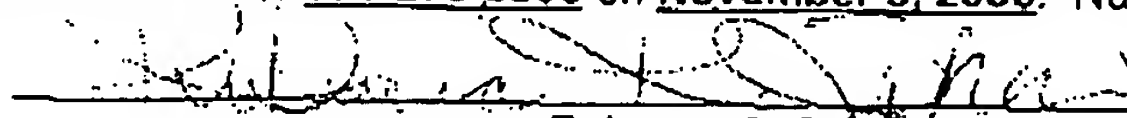
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